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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,995	12/27/2005	Junichi Hamada	52433/829	5923
26646 7590 05/27/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER YANG, JIE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
05/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/562,995

**Applicant(s)**

HAMADA ET AL.

**Examiner**

JIE YANG

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) 4-6 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 11/13/2007;12/27/2005  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Inventor's Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of "Group I—Claims 1-3, drawn to a product of a ferric stainless steel" in the reply filed on 4/21/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP 818.03(a)).

Claims 4-6 are withdrawn from consideration as being directed to a non-elected group and claims 1-3 are pending for examination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oku et al (US 6,673,166 B2, thereafter US'166).

Regarding claims 1-3, US'166 teaches a ferritic stainless steel (Abstract, Claims 1-5, and Col.6, line 4-Col.7, line 67 of US'166). The comparison of compositions between the instant invention and US'166 is listed in following table. All of the composition ranges disclosed by US'166 (Abstract, Claims 1-5,

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and Col.6, line 4-Col.7, line 67 of US'166) overlap the composition ranges of the instant invention, which is a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to select the claimed compositions C, Si, Mn, P, N, Cr, Nb, Mo, and Fe (Claim 1); adding one or more from Ti, Al, and B (Claim 2); and further adding one or more from Cu and W (Claim 3) from the composition disclosed by US'166 because US'166 discloses the same utility throughout the disclosed ranges. SEE MPEP 2144.05 I. US'166 teaches precipitate no more 0.5wt% (Abstract of US'166), which overlaps the 0.05-0.6wt% precipitate range as recited in the instant claim 1.

Element	From instant Claim 1 (in wt%)	US'166 (in wt%)	Overlapping range (in wt%)
C	0.001-0.010	0-0.03	0.001-0.010
Si	0.01-0.3	0-2.0	0.01-0.3
Mn	0.01-0.3	0-2.0	0.01-0.3
P	0.01-0.04	0-0.04	0.01-0.04
N	0.001-0.020	0-0.03	0.001-0.020
Cr	10-20	9-35	10-20
Nb	0.3-1.0	0.15-0.8	0.3-0.8
Mo	0.5-2.0	0-3.0	0.5-2.0
Fe	Balance	Balance	Balance
Selected one	From instant claim 2		
Ti	0.05-0.20	0-0.5	0.05-0.20
Al	0.005-0.100	0-6.0	0.005-0.100
B	0.0003-0.0050	0-0.05	0.0003-0.0050
Selected one	From instant claim 3		
Cu	0.2-3.0	0-2.0	0.2-2.0
W	0.01-1.0	0-3.0	0.01-1.0
Sn	0.01-1.0	--	--

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-2 of patent US 7,267,730 (Hereafter US'730) in view of US'166.

Although the conflicting claims are not identical, they are not patentable distinct from each other because the claims of US 7,267,730 teach the similar composition of a ferritic stainless steel as disclosed in the instant claims 1-3. US'730 does not claim the total precipitates from 0.05wt% to 0.60wt%. US'166 teaches the similar composition of a ferritic stainless steel

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and precipitate no more 0.5wt% (Abstract of US'166), which overlaps the 0.05-0.6wt% precipitate range as recited in the instant claim 1. Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention was made to control the precipitate amount, for example, 0.05 to 0.6wt% as recited in the alloy of US'730 in view of US'166 in order to obtain good workability (Col.1, lines 6-9 of US'166). Thus, no patentable distinction was found in instant claims compared with claims 1-2 of US'730 in view of US'166.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-2701884.

The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/

Supervisory Patent Examiner, Art Unit 1793